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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,819	06/27/2001	Paul A. Moskowitz	I01.011	3539

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FIVE ELM STREET  
NEW CANAAN, CT 06840

EXAMINER

SHIFERAW, ELENI A

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/892,819

Applicant(s)

MOSKOWITZ ET AL.

Examiner

Eleni A Shiferaw

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 27 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-11 and 13-40 is/are rejected.
- 7) ☒ Claim(s) 7 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Final Rejection**

**Response to the applicant's amendments**

1. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-6, 8-11, 13, 15-17, 19-22, 24-25, 27-31, and 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips (Pub. No.: US 2002/0107802A1) in view of Akiyama et al. (Akiyama, Patent Number: 5,805,699).

As per claim 1, 16, and 24, Phillips teaches a method/medium/apparatus for transferring electronic information, comprising:

a processor (Phillips Fig. 1 No. 52); and

a storage device in communication with said processor and storing instructions adapted to be executed by said processor to (Phillips page 3 par. 0033):

receive a command to transmit a file of electronic information (Phillips page 1 par. 0005 lines 6-8; a user commands the user's device to transmit a music file of electronic information); and

in response to the received command to transmit the portion of the file of electronic information, automatically copy the portion of the file of electronic information to create a copied file of electronic information, transmit the copied file to an entity (Phillips page 1 par. 0005 lines 6-8; in response to the user's command to transmit the copied/portion of the music file of electronic information, automatically copy the music file of the original received file of electronic information when a user selects a forward button),

Phillips fails to teach rendering the portion of the file of electronic information unusable.

However Akiyama discloses copying an encrypted copyrighted software records to be stored on user's target computer but the stored encrypted copyrighted software is rendered unusable unless deciphered by a user (Akiyama Col. 4 lines 34-42).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Akiyama within the system of Phillips because it would render the data unusable or it would never be usable data until the stored encrypted copyrighted software is deciphered by the user (Akiyama Col. 2 lines 48-67).

As per claims 10, 22, and 30, Phillips teaches a method/medium/apparatus for providing a file of electronic information, comprising:

a processor (Phillips Fig. 1 No. 52); and  
a storage device in communication with said processor and storing instructions adapted to be executed by said processor to (Phillips page 3 par. 0033):  
provide a file of electronic information; and  
receive a copy of a portion of the file of electronic information (Phillips page 1 par. 0005 lines 6-8, and/or page 1 par. 11 lines 6-8; other consumer received a copy of a portion of the music file transmitted and/or receiving device receives a copy of audio/video track/pre-recorded audio/video data);

Phillips fails to teach the portion of the file of electronic information that has been copied has been rendered unusable, and  
receiving a certificate certifying the portion of the file of electronic information that has been copied has been rendered unusable;

However Akiyama discloses copying an encrypted copyrighted software records to be stored on user's target computer but the stored encrypted copyrighted software is rendered unusable unless deciphered by a user (Akiyama Col. 4 lines 34-42), and

a first digital signature, generated by central site, serves as a certificate of a license to copy the software product (Akiyama Col. 2 lines 18-19), and a second digital signature, generates a new signature and compares with the one stored on the users device to retrieve data from master storage medium and copy the data to the user's device (Akiyama Col. 2 lines 26-38).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Akiyama within the system of Phillips because it would render the data unusable or it would never be usable data until the stored encrypted copyrighted software is deciphered by the user (Akiyama Col. 2 lines 48-67) and one skilled in the art would modify the teachings of Akiyama's digital signature certificate to certify the portion of the file of the electronic information that has been rendered unusable because it would inform the provider/owner the portion of the copied file to the user is not usable.

As per claim 32, Phillips teaches a system for transferring electronic information, comprising:

- a subscription device comprising (Phillips Page 1 par. 0009; an electronic network):

- a first processor (Phillips Page 2 par. 0032); and

- a first storage device in communication with the first processor and storing instructions adapted to be executed by the first processor to (Phillips Page 3 par. 0033):

- transmit a file of electronic information according to a subscription (Phillips Page 1 par. 0009; user requests an audio/video data and the requested electronic data is transmitted to the user); and

- a consumer device comprising (Phillips Page 1 par. 0009; user device):

- a second processor (Phillips Fig. 1 No. 52); and

a second storage device in communication with the second processor and storing instructions adapted to be executed by the second processor to (Phillips Page 3 par.

0033):

receive the file of electronic information (Phillips Page 1 par. 0011 lines 6-8; user device receives audio/video data);

receive a command to transmit a portion of the file of electronic information (Phillips page 1 par. 0005 lines 6-8; a user commands the user's device to transmit a portion of music file of electronic information);

determine whether the portion of the file of electronic information should be automatically copied (Phillips page 1 par. 0005 lines 6-8; a user device determines whether the forward button is selected to automatically copy the portion of the music file of electronic information);

automatically copy the portion of the file of electronic information to create a copied file of electronic information in response to the determination (Phillips page 1 par. 0005 lines 6-8; a user device automatically copies the portion of the music file of electronic information when forward button is selected);

transmit the copied file to an entity (Phillips Page 1 par. 0005 lines 6-8; a user device transmitting the copied music file to an entity/other consumer); and

Phillips fails to teach to render the portion of the file of electronic information unusable,  
and

receiving/transmitting a certificate certifying that a portion of the file of electronic information has been rendered unusable;

However Akiyama discloses copying an encrypted copyrighted software records to be stored on user's target computer but the stored encrypted copyrighted software is rendered unusable unless deciphered by a user (Akiyama Col. 4 lines 34-42), and

a first digital signature, generated by central site, serves as a certificate of a license to copy the software product (Akiyama Col. 2 lines 18-19), and a second digital signature, generates a new signature and compares with the one stored on the users device to retrieve data from master storage medium and copy the data to the user's device (Akiyama Col. 2 lines 26-38).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Akiyama within the system of Phillips because it would render the data unusable or it would never be usable data until the stored encrypted copyrighted software is deciphered by the user (Akiyama Col. 2 lines 48-67) and one skilled in the art would modify the teachings of Akiyama's digital signature certificate to certify the portion of the file of the electronic information that has been rendered unusable because it would inform the provider/owner the portion of the copied file to the user is not usable.

As per claims 2, 9, 17, and 25, both Phillips and Akiyama teach all the subject matter as described above. In addition, a method/medium/apparatus, comprising:



determining whether the portion of the file of electronic information should be automatically copied (Phillips page 1 par. 0005 lines 6-8; a user device determines whether the forward button is selected to automatically copy the portion of the music file of electronic information) and rendered unusable (Akiyama Col. 4 lines 34-42). The rational for combining are the same as claim 1 above.

As per claims 4, 19, and 27, both Phillips and Akiyama teach all the subject matter as described above. In addition, a method/medium/apparatus, further comprising: determining that the portion of the file of electronic information has been rendered unusable (Akiyama Col. 2 lines 48-67 and col. 4 lines 34-42; determining that the portion/copy of the music file of electronic information rendered unusable); and transmitting a certificate (Akiyama Col. 2 lines 18-19) the portion of the file of electronic information has been rendered unusable (Akiyama Col. 4 lines 34-42).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to employ the teachings of Akiyama within the system of Phillips because would modify the teachings of Akiyama's digital signature certificate to certify the portion of the file of the electronic information that has been rendered unusable because it would inform the provider/owner the portion of the copied file to the user is not usable.

As per claims 5, 20, and 28, both Phillips and Akiyama teach all the subject matter as described above. In addition, a method/medium/apparatus, wherein the file is received from an entity (Phillips Page 1 par. 0011 lines 6-8), and wherein the certificate is transmitted to the entity (Akiyama Col. 4 lines 24-26). The rational for combining are the same as claim 1 above.

As per claims 6, 13, 21, and 29, both Phillips and Akiyama teach all the subject matter as described above. In addition, a method/medium/apparatus, wherein the certificate (Akiyama Col. 4 lines 24-34) is transmitted to an owner of a copyright in the file of electronic information (Akiyama Col. 4 lines 24-34; transmitting a certificate to the user, one ordinary skill in the art would transmit the certificate to the owner because the owner would be informed that the portion of the copied file is not usable in order to protect unauthorized copying of data).

As per claims 8 and 15, both Phillips and Akiyama teach all the subject matter as described above. In addition, Phillips teaches a method, wherein the electronic information comprises at least one of an image, text, multimedia, a movie, audio, music, software, news, weather, sports news, and data (Phillips Page 1 par. 0009; audio/video data).

As per claim 9, both Phillips and Akiyama teach all the subject matter as described above. In addition, Phillips teaches a method, wherein the step of automatically copying comprises at least one of creating an electronic mail message, copying to electronic storage, copying to magnetic storage, and copying to optical storage (Page 1 par. 0005 lines 6-8).

As per claim 11, both Phillips and Akiyama teach all the subject matter as described above. In addition, Phillips teaches a method, wherein the file is provided to a consumer in fulfillment of a subscription (Phillips Page 1 par. 0009).

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As per claim 33, both Phillips and Akiyama teach all the subject matter as described above. In addition, Phillips teaches a system, wherein the copied file is transmitted to the subscription device (Phillips page 1 par. 0005 lines 6-8; transmitting the copied file to the other consumer, it would be obvious to one having ordinary skill in the art at the time of the invention to transmit the copied file to the subscription because it would certify the subscription that the portion of the copied file is rendered unusable).

As per claims 34-40, both Phillips and Akiyama teach all the subject matter as described above. In addition, Phillips teaches a method/medium/apparatus, wherein the portion of the file of electronic information is the entire file of electronic information (Phillips Page 1 par. 0005 lines 6-8).

4. Claims 3, 14, 18, 23, 26, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips (Pub. No.: US 2002/0107802A1) in view of Akiyama et al. (Akiyama, Patent Number: 5,805,699), and further in view of Bouet et al. (Bouet, Pub. No.: US 2002/0065778 A1).

As per claims 3, 18, 26, Phillips and Akiyama teach all the subject matter as described above.

Phillips and Akiyama fail to teach an electronic tag associated with the portion of the file of the file of electronic information.

However Bouet teaches a tag counter to indicate and determine a number of times a user can transmit/forward a multimedia file (Bouet Page 6 par. 0005).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the teachings of Bouet within the combination system of Phillips and Akiyama because it would determine that the file should be automatically copied and rendered unusable when the user commands the user device to transmit the received data back to the provider/owner.

As per claims 14, 23, and 31, Phillips and Akiyama teach all the subject matter as described above.

Phillips and Akiyama fail to teach an electronic tag indicating that the portion of the file should be rendered unusable if the portion of the file is copied.

However Bouet teaches a tag counter to indicate and determine a number of times a user can transmit/forward a multimedia file (Bouet Page 6 par. 0005, and fig. 8).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the teachings of Bouet within the combination system of Phillips and Akiyama because it would determine that the file should be automatically copied and rendered unusable when the user commands the user device to transmit the received data back to the provider/owner.

*Allowable Subject Matter*

5. Claims 7 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A Shiferaw whose telephone number is 571-272-3867. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eleni Shiferaw

Art Unit 2136  
March 8, 2005

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100